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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/970,730	10/05/2001	Steven W. Trovinger	10013280	1262

7590

06/30/2003

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

DURAND, PAUL R

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 06/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

EC

Office Action Summary

Application No.

09/970,730

Applicant(s)

TROVINGER ET AL.

Examiner

Paul Durand

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-16, 19, 20 and 22 is/are rejected.
- 7) ☒ Claim(s) 4, 17, 18, 21 and 23 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4, 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1,2,3,5,6-10,13-16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nemec (US 4,419,088) in view of Trovinger (WO 00/18583).

In regard to claims 1 and 14, Nemec discloses the invention substantially as claimed including a fold blade 31, two fold rollers 21 and 22, that rotate about an axis parallel to the longitudinal axis of the fold blade, and drive means for moving the rollers and blades (see Figs. 1, 7a, 8a and C2,L67 - C3,L58). What Nemec does not disclose is a pinch foot that clamps against the fold blade. However, Trovinger discloses that it is well known in the art of folding to provide a pinch roller 231, with a footprint that clamps against a fold blade for the purpose of keeping a sheet of paper correctly aligned thereby increasing manufacturing efficiency (see Figs. 14-22 and Pg. 22,L26 – Pg. 27,L18). Therefore, it would have been obvious to one having ordinary skill in the art to have modified the invention of Nemec with the pinching means as taught by Trovinger for the purposes of increasing manufacturing efficiency.

In regard to claims 2,5,6-10,13,15 16 and 19 Nemec discloses the invention substantially as claimed including guides 13 and 14, fold rollers 21 and 22 attached to housings 24 and 25 and rods 33 to move the blade 31, attached to couplings 35,

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through a plane which passes between the fold rollers. What Nemec does not disclose is the vertically adjustable rollers, However, Trovinger teaches that it is old and well known in the art of folding to provide folding flaps 230, vertically adjustable rollers 238 orthogonal to the paper, with a housing 211, attached to a coupling 216, with lead screw 215 and pinch rollers 231 elastically mounted by spring and rods 235 in between rollers 238, for the purposes of increasing manufacturing efficiency (see Figs. 14-22).

Therefore, it would have been obvious to one having ordinary skill in the art to have modified the invention of Nemec with the pinching and adjusting means as taught by Trovinger for the purpose of increasing manufacturing efficiency.

In regard to claim 3, Nemec discloses the invention substantially as claimed except for the rounded folding blade. It would have been an obvious matter of design choice to use a rounded folding blade, since applicant has not disclosed that a rounded folding blade solves any stated problem or is valid for any particular purpose and it appears that the invention would perform equally well with either a flat or rounded folding blade

3. Claims 11,12,20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nemec in view of Trovinger and in further view of Skipor et al (US 3,954,258).

In regard to claims 11 and 12, Nemec and Trovinger discloses the invention substantially as claimed including folding flaps 230. What Nemec and Trovinger do not disclose is adjustable flaps with fold rollers attached to the flaps. However, Skipor discloses that it is old and well known in the art of folding to provide folding flaps 18 and

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20 that are pivotably biased toward each other and have fold rollers 14 attached (see Fig. 1) for the purpose of increasing manufacturing efficiency. Therefore, it would have been obvious to one having ordinary skill in the art to have modified the invention of Nemec with the pinching and adjusting means as taught by Skipor for the purpose of increasing manufacturing efficiency.

In regard to claims 20 and 22, Skipor teaches that it is old and well known to provide fold rollers that rotate the axis in a different direction.

Allowable Subject Matter

4. Claims 4,17,18,21 and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

5. Applicant's arguments filed 4/11/03 have been fully considered but they are not persuasive.

6. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re*

Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Applicant firstly argues that there is not suggestion to combine based on the mode of operation. While the examiner agrees that the mode of operation in that the fold rollers operate on different axes, the Examiner contends that the primary reference of Nemec clearly shows the fold rollers operating aligned along the same axis as the folding blades. The Trovinger teaching is utilized to show applicant that it is old and well known to use a pinching means that allows the machine to maintain a sheet of paper correctly aligned during a folding operation.

7. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., movement of the drive rollers) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant further argues that the inventions are different from a drive means perspective. Applicant argues that the drive means in the invention moves the drive rollers toward the folding blade while Nemec clearly shows the drive means moving the blade toward the rollers. While the Examiner agrees with applicant in this regard, the broadly written limitation in the applicant's independent claims "drive means ...with one another" does not limit the method or apparatus in a manner that can overcome the primary reference of Nemec. As the examiner has interpreted the claim, the limitation only limits the claim to some kind of movement between the fold rollers and the folding blade and does not differentiate between the movement of the either one.

Therefore, for the reasons indicated above, the rejection is deemed proper.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Durand whose telephone number is 703-305-4962. The examiner can normally be reached on 0730-1800, Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on 703-308-2187. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Paul Durand
June 17, 2003

A handwritten signature in black ink, appearing to read "Stephen F. Gerrity". The signature is stylized with a large, looped "S" and a long, sweeping "y" at the end.

Stephen F. Gerrity
Primary Examiner